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on June 25 2003

By

Sara B. McPeak
Sara B. McPeak

PATENT

Attorney Docket No. 20375-022200US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Lynn Holm Blagg et al.

Application No.: 09/298,521

Filed: April 23, 1999

For: METHOD FOR DEFINING A
RELATIONSHIP BETWEEN AN
ACCOUNT AND A GROUP

Art Unit: 3624

Examiner: Alain L. Bashore

APPELLANTS' REQUEST TO
REINSTATE THE APPEAL and
SUPPLEMENTAL APPEAL BRIEF
UNDER 37 C.F.R. §1.193(b)(2)(ii)

Assistant Commissioner for Patents
U. S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

Applicants ("Appellants") timely file this REQUEST TO REINSTATE THE APPEAL and SUPPLEMENTAL APPEAL BRIEF under 37 C.F.R. §1.93(b)(2)(ii) in response to the reopening of prosecution that was formally received on June 11, 2003.

Appellants timely filed a Notice of Appeal on August 12, 2002, and three days later filed its Appeal Brief on August 15, 2002. Fully nine months after the appeal brief was filed, the examiner left a voice mail on May 21, 2003 with Appellants' representative indicating

that the examiner and his supervisor had determined to reopen prosecution, and to issue a Requirement for Restriction. The Requirement for Restriction was issued on May 30, 2003, but failed to formally reopen prosecution. On June 10, 2003, Appellants' representative contacted the examiner seeking to understand how Appellants could respond to such a Requirement for Restriction when the case was pending appeal. After some discussion, the examiner suggested providing an Examiner's Interview Summary that would reduce the previously verbal indication that prosecution would be reopened to writing in accordance with C.F.R. §1.2, and stated that the Examiner would speak to his supervisor about the propriety of such an approach. A short time later, the examiner contacted Appellants' representative and indicated that the approach suggested by the examiner had been approved by the supervisor. Accordingly, on June 11, 2003 the examiner provided the previously suggested Examiner's Interview Summary that states in relevant part: "The restriction [of May 30, 2003] is amended to include the following: In view of the appeal brief filed on 8-15-02, PROSECUTION IS REOPENED." (emphasis original). In response, Appellants elect to reinstate the appeal, and provide this supplemental appeal brief under 37 C.F.R. §1.93(b)(2)(ii).

SUPPLEMENTAL APPEAL BRIEF:

A. INTRODUCTION

After more than nine months of delay, the examiner has chosen to reopen prosecution on the merits, however, the examiner fails to address any of the points raised in Appellant's Appeal Brief of 8/15/02. Rather, the examiner has reopened prosecution and chosen to issue a frivolous Requirement for Restriction that serves no legitimate purpose, but only furthers a continuing assiduous avoidance of the merits of the case. As set forth in the Appeal Brief of 8/15/02, when the merits of the case are squarely considered, the claims are shown to be clearly allowable. Accordingly, Appellants elect to reinstate the appeal to assure that the merits of the application as set forth in the Appeal Brief of 8/15/02 are fully considered.

As set forth in Appellants' Appeal Brief of 8/15/02, the examiner has failed to cite any art that supports a rejection of the claims at issue. Further, in reopening prosecution, the examiner has again failed to cite new art, or even to suggest that another rejection is possible. Thus, the nine plus months of consideration that has passed since Appellants filed its appeal brief has also failed to yield art capable of supporting a rejection. Accordingly, based on the Appeal Brief of 8/15/02, Appellants respectfully requests that the Board of Patent Appeals and Interferences rule the claims pending in the present application are allowable at the earliest possible time.

B. RESPONSE TO REOPENING PROSECUTION

Appellants provisionally elect claims of group II with traverse.

A careful review of the claims and the prosecution history reveals that the present Requirement for Restriction is frivolous, serving no legitimate purpose of the U.S. Patent Office, while simultaneously severely damaging appellants' interest. As set forth below, the abuse of discretion evidenced by the Requirement for Restriction should be restrained, and the Requirement for Restriction withdrawn at least because: (1) The Requirement for Restriction is Improper, and/or (2) The Requirement for Restriction is Unnecessarily Prejudicial to Appellants' Patent Rights.

(1) The Requirement for Restriction is Improper

"There are two distinct criteria for a proper requirement for restriction . . . (A) The inventions must be independent . . . or distinct as claimed; and (B) There *must* be a *serious* burden on the examiner if restriction is required . . . " MPEP §803.01 (emphasis added). "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." Id. (emphasis added). "[A] serious burden on the examiner may be *prima facie*

shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search . . ." Id.

In this case, the examiner alleges that the groups of claims are distinct, but fails to even address the second element of a proper restriction -- *that there must be a serious burden on the examiner of searching the entire application*. Indeed, not only does the examiner fail to make a *prima facie* case indicating the serious burden on the examiner of searching the entire application, he frankly admits in the Requirement for Restriction itself that such a search is not burdensome. In particular, the examiner states that the claims of both group I and group II are methods classified in class 705, subclass 35. Requirement for Restriction of 5/30/03 at ¶1. As the examiner cannot make a *prima facie* case showing a serious burden, the Requirement for Restriction is improper and should be disregarded.

The prosecution history of the present application further evidences that there is no serious burden on the examiner to search the entire application. More particularly, the examiner has previously twice rejected the claims at issue based on two searches. The most recent final rejection that gave rise to this appeal did not include any amendment to the claims, and thus it is not clear how the examiner's task has out of the blue become a "serious burden" when it has been previously performed with apparent ease. Again, searching the entire application is not a "serious burden" as indicated by the examiner both in words and deeds. Accordingly, the Requirement for Restriction should be withdrawn, and the case treated in its entirety.

(2) The Requirement for Restriction is Unnecessarily Prejudicial to Appellants' Patent Rights

35 U.S.C. §121 provides that the Commissioner *may* require restriction if two or more "independent and distinct" inventions are claimed in one application. "The validity of a patent shall not be questioned for failure of the [Commissioner] to require the application to be restricted . . ." 35 U.S.C. 121. Thus, where the requirements for a restriction are first met, it is

purely discretionary whether a restriction should be required. Such discretion should not be exercised in such a way as to inflict unnecessary damage to the appellants.

Since GATT, the patent term expires twenty years from filing, thus filing a divisional at a late stage of prosecution can result in a severely reduced patent term. Thus, used improperly, the discretion vested in the Commissioner to restrict can effectively deny warranted patent rights. Perhaps because of the pernicious effects of late term restriction requirements, "[s]uch requirement will normally be made before any action on the merits . . ." 37 C.F.R. §1.142. And certainly "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." MPEP at §811.

The prejudice to Appellants in this case is truly exceptional, and should not be inflicted where for no legitimate purpose, the examiner has decided to effect a requirement for restriction at this late stage of the prosecution. In this case, over five years of the patent term has elapsed with only some of that patent term being reclaimed through the patent term extension provisions of 37 C.F.R. §1.701. Based on the prosecution progress of the present application, were the Requirement for Restriction enforced, the patent term of any divisional application required to pursue the restricted claims could conceivably be ten years or less. Certainly the discretion vested in the Commissioner was not intended, and should not be used to effectively deny patent rights. Thus, even where, *arguendo*, the restriction were proper, the restriction is discretionary and should not be applied where such unnecessary prejudice to Appellants' patent rights would be inflicted. Hence, where the Requirement for Restriction is both improper, and highly prejudicial, it clearly should not be enforced, but rather withdrawn.

C. CONCLUSION

"The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner." MPEP at §1208. This written statement "should contain a response to the allegations or arguments in the

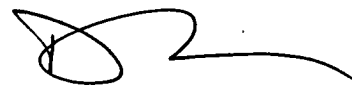
brief . . . If any rejection is withdrawn, the withdrawal should be clearly stated in the Examiner's answer under 'Issues.'" Id. "Grounds for rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so." Id. These rules are intended to assure that the issues are framed properly, and that prosecution proceeds at an expeditious pace.

In this case, rather than provide such a written statement within two months and squarely address the issues, the examiner has chosen to wait in excess of nine months to inflict yet further delay in the prosecution process by reopening prosecution and issuing a frivolous Requirement for Restriction. This appears to be an attempt to force Appellants to rejoin a process contrived to avoid any further consideration of the merits of the case and by default deny issuing Appellants' patent application, even though proper application of the Law clearly supports granting the application.

As set forth in Appellants' Appeal Brief of 8/15/02, the examiner has failed to cite any art that supports a rejection of the claims at issue. Further, in reopening prosecution, the examiner has again failed to cite new art, or even to suggest that another rejection is possible. Appellants' application should be allowed in its entirety for at least the reasons set forth in Appellants' Appeal Brief, as well as those set forth herein. Accordingly, Appellants respectfully requests the Board of Patent Appeals and Interferences rule the claims pending in the present application allowable at the earliest possible time.

No fee is believed to be due, however, if any are due, please deduct the requisite fees from deposit account 20-1430.

Respectfully submitted,



Douglas M. Hamilton
Reg. No. 47, 629

June 25, 2003
Date

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DE 7108420 v1

PTO FAX NO.: 703-305-7687

Atty Docket No. 20375-022200

ATTENTION: Examiner Alain L. Bashore
TELEPHONE NO.: 703-308-1884

Group Art Unit 3624

OFFICIAL COMMUNICATION
FOR THE PERSONAL ATTENTION OF
EXAMINER ALAIN L. BASHORE
CERTIFICATION OF FACSIMILE TRANSMISSION

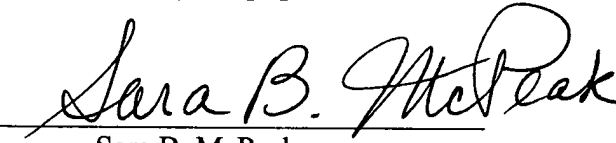
I hereby certify that the following document(s) in re Application of Lynn Holm Blagg et al., Application No. 09/298,521, filed April 23, 1999 for METHOD FOR DEFINING A RELATIONSHIP BETWEEN AN ACCOUNT AND A GROUP is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal Form (1 page in triplicate)
2. Transmittal of Appellants' Request to Reinstate the Appeal and Supplemental Appeal Brief Under 37 C.F.R. 1.193(b)(2)(ii) (2 pages in triplicate)
3. Appellants' Request to Reinstate the Appeal and Supplemental Appeal Brief Under 37 C.F.R. 1.193(b)(2)(ii) (6 pages in triplicate)

Number of pages being transmitted, including this page: 28

Dated: June 25, 2003


Sara B. McPeak

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* * * COMMUNICATION RESULT REPORT (JUN. 25. 2003 9:40AM) * * *

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Atty Docket No. 20375-022200

ATTENTION: Examiner Alain L. Bashore
TELEPHONE NO.: 703-308-1884

Group Art Unit 3624

OFFICIAL COMMUNICATION

FOR THE PERSONAL ATTENTION OF

EXAMINER ALAIN L. BASHORE

CERTIFICATION OF FACSIMILE TRANSMISSION

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PATENT
Attorney Docket No.: 20375-022200

On June 25, 2003

TOWNSEND and TOWNSEND and CREW LLP

By: Sara B. McPeak

Sara B. McPeak

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

In re application of:

Lynn Holm Blagg et al.

Application No.: 09/298,521

Filed: April 23, 1999

For: METHOD FOR DEFINING A
RELATIONSHIP BETWEEN AN
ACCOUNT AND A GROUP

Examiner: Alain L. Bashore

Art Unit: 3624

TRANSMITTAL OF APPELLANTS'
REQUEST TO REINSTATE THE APPEAL
and SUPPLEMENTAL APPEAL BRIEF
UNDER 37 C.F.R. §1.193(b)(2)(ii)

Commissioner of Patents and Trademarks
U. S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

Appellants hereby transmit three (3) copies of the REQUEST TO REINSTATE THE APPEAL and SUPPLEMENTAL APPEAL BRIEF under 37 C.F.R. §1.193(b)(2)(ii) in connection with the appeal in the above-captioned application. The NOTICE OF APPEAL UNDER 37 C.F.R. 1.191 was filed by facsimile transmission on August 12, 2002 and received by the Patent and Trademark Office on August 12, 2002. The APPELLANTS' APPEAL BRIEF UNDER 37 C.F.R. §1.192 was filed by facsimile transmission on August 15, 2002 and received by the Patent and Trademark Office on August 15, 2002.

Appellants believe no fee is necessary at this time, however, if any are due, please deduct the requisite fees from Deposit Account No. 20-1430.

☒ THIS REQUEST TO REINSTATE THE APPEAL and SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. §1.193(b)(2)(ii) is being filed under 37 C.F.R. 1.8 and the required Certificate of Facsimile transmission appears above.

☐ Appellants hereby request an oral hearing pursuant to 37 C.F.R. 1.194 and hereby request that the fee for filing a request for oral hearing, \$ _____, or such greater or lesser amount as the Commissioner may deem is required by 37 CFR 1.17(d), be charged to Deposit Account No. 20-1430.

☒ Appellants reserve the right to request an oral hearing pursuant to 37 C.F.R. 1.194 following receipt of the Examiner's Answer.

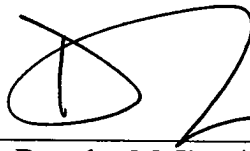
☐ A Petition to Extend Time is enclosed.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

Date: June 25, 2003

By



Douglas M. Hamilton
Reg. No. 47,629

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Enclosures: APPELLANTS' REQUEST TO REINSTATE THE APPEAL and
SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. §1.193(b)(2)(ii) (in triplicate)